

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
(Attorney Docket No. 14275US02)**

In the Application of:

Jeyhan Karaoguz, et al.

Serial No. 10/675,076

Filed: September 30, 2003

For: METHOD AND SYSTEM FOR
TV INTERFACE FOR
COORDINATING MEDIA
EXCHANGE WITH A MEDIA
PERIPHERAL

Examiner: Macilwinen, John Moore Jain

Group Art Unit: 2442

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REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

This Paper responds to the Examiner's Answer mailed June 29, 2010. For at least the reasons set forth in the Appeal Brief and this Reply Brief, the Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-34 of the present application.

REMARKS

I. Claims 27 And 31 Are Fully Supported By The Specification And Drawings

The Examiner's Answer maintains the rejection of claims 27 and 31 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description because the specification allegedly does not describe, a "'third home' and media 'from a third home.'"

The Examiner's Answer "has not taken the position that transfer between a first and second home is not supported. In other words, the Examiner agrees that the transfer between the above recited 'user's home' and 'friend's home' is indeed supported." *See* Examiner's Answer at page 15. However, the Examiner's Answer alleges that the specification provides "no support for transferring media from a first home to a third home, as arranged by a second home." *See id.* As noted in the Appeal Brief, the Examiner's Answer seemingly maintains this rejection because the specification does not specifically recite "third home." Indeed, the Examiner's Answer states that the "Specification does include multiple locations and also includes homes." *See id.* at page 18.

As noted previously, however, the specification notes "[t]ransfer of the media from the first location to **one or more other locations**...." *See* present application at, for example, page 4, lines 15-18 (emphasis added). Thus, the present application clearly notes transfer of media from a general first location to one or more or other locations. The first location may be a home, while the other locations may also be homes, as noted in the present application at, for example, page 8, lines 26-27, and page 9, lines 4-5.

As explained in the Appeal Brief at pages 7-8, the specification of the present application provides support for a "third home" and "media from a third home." Thus, the Applicants respectfully request reconsideration of this claim rejection.

The Examiner's Answer implicitly acknowledges that transfer of media from a first location to a third location, as arranged by a second location, is fully supported by the specification in that the Examiner's Answer does not suggest that claim 1, for example, is not fully supported by the specification. That is, claim 1, for example,

recites "transferring the media from ... a first geographic location that is remotely located from the home location to at least a second media processing device at a second geographic location ... according to said controlling communication from said television in the home location." See also claims 11 and 21, for example. Again, the Examiner's Answer implicitly acknowledges that these claims are fully supported by the specification.

As noted previously,

The function of the description requirement is to ensure that the inventor had possession of, as of the filing date of the application relied upon, the specific subject matter later claimed by him; how the specification accomplishes this is not material. **The claimed subject matter need not be described *in haec verba* to satisfy the description requirement.**

In re Herschler, 591, F.2d 693, 700-701 (CCPA 1979) (citations omitted) (emphasis added).

It is not necessary that every permutation within a generally operable invention be effective in order for an inventor to obtain a generic claim, provided that the effect is sufficiently demonstrated to characterize a generic invention.

Capon v. Eshhar, 418 F.3d 1349, 1359 (Fed. Cir. 2005).

As explained in the Appeal Brief and above, the present application provides written description support for "a television, within a media processing system, located at a second home that is remotely located from the first home, wherein said television is utilized to arrange delivery of media from a third home that is remotely located from said first and second homes to said media peripheral at said first home," as recited in claims 27 and 31.

Thus, for at least these reasons, the Applicants respectfully submit that the specification and drawings support claims 27 and 31.

II. Claims 28 And 32 Are Fully Supported By The Specification And Drawings

The Applicants next turn to the rejection of claims 28 and 32 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description because

"both of a media peripheral" is allegedly not disclosed in the specification. As explained in the Appeal Brief at pages 8-9, the present application provides written description support for these claims. For example, the limitations are clearly described in the specification at, for example, page 13, lines 9-10 ("The exchange of media may also take place between a television and one or more media peripherals 110, 111, 112, 113 or media storage devices 103, 106, 107.") See also *id.* at Figure 1 (note the location of media peripherals 110, 111, 112, and 113).

III. McKenna Does Not Anticipate Claims 1-6, 8-15, And 17-24

The Applicants now turn to the rejection of claims 1-6, 8-15, and 17-24 as being anticipated by McKenna. The Applicants demonstrate that McKenna does not anticipate claims 1-6, 8-15, and 17-24 in the Appeal Brief at pages 9-14.

The Applicants note that the "broadest construction rubric coupled with the term 'comprising' does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teaching in the underlying patent." See *In re Suitco Surface, Inc.*, 2010 U.S. App. LEXIS 7620 (Fed. Cir. April 14, 2010) (emphasis added)

A. Independent Claims 1, 11, And 21

Claim 1 recites, in part, "controlling communication of the media from a television, in a home location, within a media processing system, without consuming the media by said television during said controlling, wherein said media processing system comprises a plurality of media processing devices at a plurality of geographic locations; and transferring the media from a first media processing device at a first geographic location that is remotely located from the home location to at least a second media processing device at a second geographic location that is also remotely located from the home location according to said controlling communication from said television in the home location."

The claim does not recite that the media is stored within the television in the home location. Instead, claim 1, for example, recites that communication of the media is controlled from the television in the home location, not that the media is "from" the television.

The Examiner's Answer states that "claim 1 does not recite that the home location may not store media or that the home location may not be a sender of media...." See Examiner's Answer at page 23. However, this statement is not relevant to the claim limitations.

The claim is clear that the **first and second locations are both remotely located from the home location**. Therefore, the claim recites three different locations: (1) the home location, (2) the first geographic location, and (3) the second geographic location, each of which is separate and distinct from one another. Further, the **television in the home location** provides the **controlling** communication to transfer media **from the first geographic location to the second geographic location**. McKenna simply does not describe, teach, or suggest such limitations. See Appeal Brief at pages 9-13.

Note, claim 1 does **not** recite that media is being transferred from the home location to the first or second geographic location (or from one of the first and second geographic locations to the home location). Instead, the **television in the home location** provides **controlling** of communication that results in the transfer of media **from the first location to the second location, both of which are separate and distinct from the home location**. Again, the home location is not the first or second location.

McKenna does not describe, teach or suggest that media is being sent between locations (e.g., from a first geographic location to a second location) based on a command from a separate location (e.g., a home location).

Referring to the Examiner-revised illustration in the Examiner's Answer at page 27, McKenna discloses "broadcast center 110" that broadcasts programming. See *id.* at column 6, lines 7-10.

McKenna also discloses the following:

As shown in FIG. 15, PIOs 502 may be transmitted from one system to another. For example, a PIO 502a may be transmitted via the network 101 to second STB 102b. ...

In the illustrated embodiment, a user of the source STB 102a may select the visual indicator 508a of PIO 502a.

Thereafter, the user may select, for example, the send action 504f from the context-sensitive menu 802. The send action 504f may include code for interacting with the communication component 1502 to transmit a copy of the PIO 502a to the destination 102b.

Id. at column 15, line 66 to column 16, line 21. When read in conjunction with Figure 15 of McKenna, to which the above description pertains, it is clear that the visual indicator 508a stored on STB 102a (and being shown in television 104 connected to STB 102a) is being sent from STB 102a to STB 102b. **However, McKenna does not describe, teach or suggest that a first location is commanding media to be sent from one STB 102 another 102, or vice versa, both of which are not at the first location.**

McKenna at column 6, lines 25-30 states that “a **first STB 102** may send a video transmission upstream to a first broadcast center 110, then to a second broadcast center 110, and finally downstream to a second STB 102.” *See* McKenna at column 6, lines 25-30 (emphasis added).

McKenna does not indicate that the STB 102 controls transfer of media from a first broadcast center to another broadcast center or from one of those broadcast centers to another STB 102. Instead, McKenna merely notes a sequence of transfers from the STB 102. First, the **first STB 102** sends a video transmission to a first broadcast center 110. Then, the **first STB 102** sends the transmission to another broadcast center 110. Finally, the **first STB 102** may send the transmission to another STB. In all scenarios, however, **it is the first STB 102 sending the transmission, but not the first STB 102 controlling transmission between** components that are separate and distinct from the first STB 102.

The Examiner's Answer states that the Examiner “has mapped the claimed subject matter to the teaching of McKenna [as shown in the picture labeled PICTURE 2 on page 27 of the Examiner's Answer].” *See* Examiner's Answer at page 30.

However, while the Examiner's Answer shows “PICTURE 2 (based on Fig. 1 of McKenna),” the Examiner's Answer provides additions and annotations that are not found in McKenna. Moreover, while the Examiner's Answer provides this revised

Figure, the Examiner's Answer provides no citations from McKenna that support its interpretation that results in McKenna allegedly anticipating the claims.

The Applicants respectfully submit, however, that a rejection based on anticipation cannot be supported by drawings and annotations not found in the reference and subjective interpretations that are used to read the reference on the pending claims. Indeed, the Examiner's Answer provides extremely lengthy, convoluted explanations (which often do not even focus on the claim limitations) as to what McKenna allegedly discloses. See Examiner's Answer at pages 21-36, for example. If McKenna did, in fact, disclose what the Examiner's Answer subjectively asserts that it does, it would seem that all that would be needed to prove as much would be clear and concise quotations from McKenna, as opposed to Examiner-revised Figures from McKenna, coupled with lengthy, unsupported subjective argument that often fails to address the specific claim limitations.

The Examiner's annotated figures and subjective opinions notwithstanding, as explained in the Appeal Brief at pages 9-13 and above, the Applicants respectfully submit that there is nothing in McKenna that describes, teaches, or suggests "transferring the media from a first media processing device at a first geographic location that is remotely located from the home location to at least a second media processing device at a second geographic location that is also remotely located from the home location according to said controlling communication from said television in the home location," as recited in claims 1 or 11, for example.

For the same reasons, McKenna also does not describe, teach or suggest "a television within a media processing system at a home location that is remotely located from the first geographic location, said television is utilized to arrange media delivery from a second geographic location that is remotely located from said home location to the media peripheral at the first geographic location for playback on said media peripheral," as recited in independent claim 21.

Thus, for at least these reasons, McKenna does not anticipate claims 1-6, 8-15, and 17-24.

B. Dependent Claims 4 And 14

Dependent claim 4 recites, in part, "receiving at least one request by said television for said controlling communication of the media [from said television in the home location]." Dependent claim 14 recites similar limitations. The Applicants demonstrate that the Examiner fails to explain where any cited reference describes, teaches, or suggests these limitations. See Appeal Brief at page 13.

The Office Action points, however, to the "issuance of the 'Send' instruction, shown in Fig. 15 item 504f of McKenna" and subjectively equates this with "at least one request by said television for said controlling communication of the media [from said television in the home location]." See Examiner's Answer at page 36 (emphasis added). Thus, the Office Action relies on 504f of McKenna as the claimed request noted above. However, McKenna states that an "action 504f may also be provided to send a copy" See McKenna at column 12, lines 3-5 (emphasis added). McKenna merely discloses 504f as a "send," but fails to connect it to any type of "request."

Actively "sending" something is by no means requesting. For example, if one sends an email message, that person is not asking or inquiring (i.e., requesting) whether he/she can send the email message. Instead, that person is, in fact, sending the message, similar to McKenna noting "sending a copy" with respect to 504f. "Action 504f" of McKenna (see McKenna at column 9, lines 51-55) is a "send" action, but not a "request by said television for said controlling communication of the media [from said television in the home location]," as recited in claim 4, for example.

Thus, for at least these additional reasons, the Applicants respectfully request reconsideration of the rejection of claims 4 and 14.

C. Dependent Claims 9 And 19

Dependent claim 9 recites, in part, "**scheduling said transfer** of the media from said first geographic location to at least said second geographic location utilizing said television [**in the home location, which is separate and distinct from the first and second geographic locations**] without consuming the media during said transfer." Dependent claim 19 recites similar limitations. The Applicants explain that the

Examiner has not demonstrated that McKenna anticipates claims 9 and 11. See Appeal Brief at pages 13-14.

However, the Examiner's Answer once again relies on its own "Picture 2," which is an Examiner-revised version of Figure 1 of McKenna. See Examiner's Answer at pages 37-39. Yet, the Examiner's Answer fails to cite anything from McKenna (as opposed to Examiner opinion and subjective statements) that describes, teaches, or suggests scheduling the transfer of media from a first location to a second location using a television in a home location that is separate and distinct from the first and second locations.

Thus, for at least these additional reasons, the Applicants respectfully request reconsideration of the rejection of claims 9 and 19.

IV. The Proposed Combination Of McKenna And SONICblue Does Not Render Claims 7, 17, 25, And 26 Unpatentable

The Applicants now turn to the rejection of claims 7, 17, 25, and 26 as being unpatentable over McKenna in view of SONICblue. The Applicants respectfully request reconsideration of these rejections for at least the reasons discussed above in Section III.A.

V. The Proposed Combination Of McKenna And Seo Does Not Render Claims 27-34 Unpatentable

The Applicants now turn to the rejection of claims 27-34 as being unpatentable over McKenna in view of Seo.

A. Independent Claims 27 And 31

The Applicants respectfully submit that the proposed combination of McKenna and Seo does not render claims 27, 31, and the claims that depend therefrom unpatentable for at least the reasons set forth in the Appeal Brief at pages 14-15.

B. Dependent Claims 29 And 33

Additionally, dependent claim 29 recites, in part, "wherein said **television schedules** said delivery of media to said media peripheral." Dependent claim 33 recites similar limitations. Thus, the claims are clear that the television **at the second home**, schedules delivery of media **from a third home** that is remotely located from

said first and second homes to said media peripheral at said first home. Much like the Office Action, the Examiner's Answer also does not cite to anything in McKenna or Seo that describes, teach, or suggests such scheduling of media delivery. Thus, for at least these reasons, the Applicants respectfully request reconsideration of the rejection of claims 29 and 33.

VI. CONCLUSION

For at least the reasons discussed in the Appeal Brief and above, the Applicants respectfully submit that the pending claims are allowable. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-34.

VII. PAYMENT OF FEES

The Commissioner is authorized to charge any necessary fees, or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: August 23, 2010

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